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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,340	07/11/2003	Roland Albert	071308.0447	5245
31625	7590	12/09/2004		EXAMINER
BAKER BOTTS L.L.P. PATENT DEPARTMENT 98 SAN JACINTO BLVD., SUITE 1500 AUSTIN, TX 78701-4039			PANG, ROGER L	
			ART UNIT	PAPER NUMBER
			3681	

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 10/618,340	Applicant(s) ALBERT, ROLAND
Examiner Roger L Pang	Art Unit 3681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 October 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-11 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-11, 16, 17 and 19 is/are rejected.
- 7) Claim(s) 18 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10-21-04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following action is in response to the amendment filed for application 10/618,340 filed on October 21, 2004.

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on November 11, 2001. It is noted, however, that applicant has not filed a certified copy of the German application as required by 35 U.S.C. 119(b).

Please note: apparently a copy of the application has been submitted, and an english translation of the PCT has been submitted. However, a certified ribbon copy of the German application and a copy of the actual PCT is not present within the case.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. On line 3, the limitation of 'the base plate' lacks antecedent basis. It is believed that the dependency of claim 9 should be upon claim 8 instead of 4.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 10-11, 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thorum in view of Loibl. With regard to claims 1, 10, and 16, Thorum teaches a hydraulic motor vehicle gearbox control device comprising a hydraulic distribution plate 30 having channels 32 therethrough for the distribution of hydraulic fluid to cool circuit electronics 34 of an electric control unit 16 housed on said plate, said plate having electric conductors embedded therein, and /or metallized on the surface thereof (Fig. 7B). Thorum lacks the teaching of said distribution plate being constructed of plastic. Loibl teaches a hydraulic distribution plate 30 that is constructed of plastic (Col. 6). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Thorum to employ a plastic hydraulic distribution plate in view of Loibl since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended sued as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. With regard to claim 2, Thorum teaches the device, wherein the conductors embedded in the hydraulic distribution plate are encapsulated or sprayed metal wires, pins, strips or punched latices (page 2). With regard to claims 3 and 11, Loibl teaches the device, wherein the hydraulic distribution plate is configured as an injection molded MID circuit support (Col. 2). With regard to claim 5, Thorum teaches the device, wherein the conductors extend between an electronic control unit module secured on the

hydraulic distribution plate and a gearbox connector 68 attached to the distribution plate. With regard to claim 19, Thorum teaches the device, wherein the electronic control unit module is in contact with eth electric conductors via a flexible circuit board (page 2).

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thorum in view of Loibl as applied to claim 16 above, and further in view of Clamp. Thorum teaches the device wherein the distribution plate also comprises a base plate 28 adapted for receipt of the electronic control, but lacks the teaching of said base plate being metal. Loibl teaches the device, wherein the electronic control unit module has a metal base plate 10 which is cast in they hydraulic distribution plate (Fig. 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Thorum to employ a metal base plate in view of Loibl since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended sued as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Thorum also teaches said base plate being cast into the hydraulic distribution plate. Clamp teaches a cooling unit wherein a means of attachment includes casting (Col. 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Thorum to employ casting in further view of Clamp, in order to maintain a more secure method of attachment.

Claims 4, 6, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thorum in view of Loibl as applied to claim 1 above, and further in view of Nassar. With regard to claim 4, Throum teaches the device, wherein the conductors extend between an electronic control unit module secured on the hydraulic distribution late and valves, but lacks the specific teaching of said valves comprising a solenoid valve. Nassar teaches an electronic

control unit 30 connected to at least one solenoid valve 104 for a hydraulic control system. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Thorum to employ solenoid valves in further view Nassar, in order to have precise controls of the gearbox valves. With regard to claim 6, Thorum teaches the device, wherein the electronic control unit module is in contact with eth electric conductors via a flexible circuit board (page 2). With regard to claim 7, Thorum teaches the device, wherein a channel 32 is arranged for hydraulic fluid in the hydraulic distribution plate adjacent to the electronic control unit module (Fig. 1). With regard to claim 9, Thorum teaches the device, wherein a section of the surface 28 of the hydraulic distribution plate forms the base plate of the electronic control unit module, and a circuit support of the electronic control unit module is secured directly onto this section of the surface the hydraulic distribution plate (Fig. 7b).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thorum in view of Loibl, in further view of Nassar as applied to claim 4 above, and further in view of Clamp. Thorum teaches the device wherein the distribution plate also comprises a base plate 28 adapted for receipt of the electronic control, but lacks the teaching of said base plate being metal. Loibl teaches the device, wherein the electronic control unit module has a metal base plate 10 which is cast in they hydraulic distribution plate (Fig. 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Thorum to employ a metal base plate in view of Loibl since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended sued as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Thorum also teaches said base plate being cast into the hydraulic distribution plate. Clamp teaches a cooling unit wherein a means of attachment

includes casting (Col. 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Thorum to employ casting in further view of Clamp, in order to maintain a more secure method of attachment.

Allowable Subject Matter

Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claims 1, 10 and 16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ulm, Baumel, and Beer have been cited to show similar ECU and hydraulic distribution plate arrangements.

FACSIMILE TRANSMISSION

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is (703) 305-3597. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing

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and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check should not be submitting by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 305-3597) on _____ (Date)

Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your

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response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roger L Pang whose telephone number is 703-305-0445. The examiner can normally be reached on 5:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor can be reached on 703-308-0830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Roger L Pang
Patent Examiner
Art Unit 3681

December 6, 2004